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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,606	12/08/2003	Patrick J. Sweeney	029815-0105	4015
26371	7590	03/27/2008	EXAMINER	
FOLEY & LARDNER LLP 777 EAST WISCONSIN AVENUE MILWAUKEE, WI 53202-5306				STEWART, ALVIN J
ART UNIT		PAPER NUMBER		
3774				
		MAIL DATE		DELIVERY MODE
		03/27/2008		PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/730,606	SWEENEY, PATRICK J.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alvin J. Stewart	3774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 08 February 2008.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 19-23 and 42-75 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 19-23 and 42-75 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 08 December 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/08/08 has been entered.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 42-51 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In claim 1, lines 2 and 3, the applicant positively recites part of a human, i.e. “into an intramedullary canal of a bone of a patient...”. Thus, claim 42 include a human part within the scope of the invention and are non-statutory.

A claim directed to or including within its scope a human is not considered to be patentable subject matter under 35 U.S.C. 101. The grant of a limited, but exclusive property right in a human being is prohibited by the Constitution. *In re Wakefield*, 422 F. 2d 897, 164 USPQ 636 (CCPA 1970).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 42-48, 50, 52-56, 58-65, 67-69, 73, and 74 are rejected under 35 U.S.C. 102(e) as being anticipated by Dwyer et al US Patent 7,122,056.

Dwyer et al discloses an implant (100) having a body (14) having a central canal (36) and coupled to an articular surface (ball connected to neck element 26, element 26 is connected to insert 12 and the other surface of the insert 12 is connected to the central canal (36) of body (14); a shaft (18) is coupled to the body and the shaft can be removed from the patient after implantation of the prosthesis without removing the body.

Additionally, the device is configured for replacing a hip joint or is capable of being inserted into a shoulder joint. Additionally, the shaft can be called a nail.

Finally, the modular joint of the Dwyer et al reference has a plurality of different shafts (18), see Figs. 1, 5, 6, 12A and 13 that are capable of being replaced in the embodiment of Figure 5. Also, if the shaft (18) of the embodiment of Figure 5 is damaged, the shaft (18) can be replaced by a new shaft.

Regarding claims 50, 51, 56, 57, element 48 is the insert.

Regarding claims 44, 45, 55, 63 and 64, see element 32 in Figure 5.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ganjianpour US 6,716,250 B2.

Ganjianpour discloses a prosthetic device (12) having a body (18), a head (22) and a shaft (26) comprising creating an access aperture in the patient and a shaft capable of removing the shaft from the patient without removing the body and the head.

However, Ganjianpour does not disclose the steps of removing the shaft without removing the body and the head and inserting a second replacement shaft into the patient.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the original shaft (26) by a new a new shaft in order to replace a broken shaft.

Claims 49, 51, 57, 66, 70-72 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dwyer et al US Patent 7,122,056.

Dwyer et al discloses the invention substantially as claimed. However, Dwyer et al does not disclose a locking element configured to be screwed into the central canal to lock the first shaft in place and does not disclose a shaft removal device configured to remove the first shaft from the central canal.

Regarding the shaft removal, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the Dwyer et al reference by using a delivering tool, such as a pliers, in order to insert or remove the prosthetic shaft.

The Dwyer et al is silent regarding the opening and closing of the access aperture, however, it is an inherent characteristic to open the patient's body in order to replace a damaged joint and close the patient's body after the surgeon finished fixing the damaged joint.

Regarding the length of the first and second shafts, Dwyer et al discloses the claimed invention except for the teaching of having different shafts length. It would have been an obvious matter of design choice to have a plurality of modular shafts with different lengths, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claims 51, 57, and 66, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the taper interlock of element 12 with the taper cavity of element 14 by a threaded cavity with a threaded post in order to make a strong and fixed connection between two structures.

### ***Response to Arguments***

Applicant's arguments with respect to claims 19-23, and 42-75 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin J. Stewart whose telephone number is 571-272-4760. The examiner can normally be reached on Monday-Friday 7:00AM-5:30PM(1 Friday B-week off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alvin J Stewart/  
Primary Examiner, Art Unit 3774

March 24, 2008.